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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,558	12/06/2000	Ronald R. Marquardt	3027 .00014	8576

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04/17/2003

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EXAMINER

GRUN, JAMES LESLIE

ART UNIT

PAPER NUMBER

1641

16

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/673,558

Applicant(s)
MARQUARDT et al.

Examiner
James L. Grun, Ph.D.

Art Unit
1641



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 Oct 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Technology Center 1600, Group 1640, Art Unit 1641.

The amendment filed 18 October 2002 is acknowledged and has been entered. Claims 1-21 remain in the case. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-11, the relationships of an enzyme or reactant to a biomolecule, particularly to any of the alternatives to an enzyme listed in claim 10, are not clear, nor is the relationship clear for measuring enzymatic activity versus "the" activity or concentration of a biomolecule. The examiner would suggest --the activity of the enzyme-- in line 14.

In claims 6 and 7, "the biological activity" lacks antecedent basis. The subject matter of these claims provides no further limitation of the enzymatic activity as claimed in claim 1.

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In claims 8 and 9, "the biological activity" (as well as any such activity of the biomolecule) lacks antecedent basis.

In claim 10, the recited Markush group is broader in scope and does not further limit the enzyme as claimed in claim 1.

Claim 11 does not further limit the invention of claim 1 because there is no antecedent basis for "the compound" component.

Claims 12, 14-18, and 20-21 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Behnke et al (U.S. Pat. No. 5,573,921) for reasons of record.

Claims 12-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Marquardt et al (WO 97/43438), Eibl et al (U.S. Pat. No. 4,276,259), Fish et al (U.S. Pat. No. 5,126,276), and Köhler (U.S. Pat. No. 4,822,565) for reasons of record.

Applicant's arguments filed 18 October 2002 have been fully considered but they are not deemed to be persuasive. Applicant urges that certain limitations distinguish the claims over the cited prior art because the prior art references teach additional steps, such as washing steps, in their methods. This is not found persuasive because applicant's arguments are drawn to limitations not found in the instantly rejected claims. Notwithstanding applicant's assertions to the contrary, no amendments have been made to enter any of the argued limitations into the instantly rejected claims and the instant open claim language does not exclude any additional

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steps. It is again noted that coating and washing steps for the probe prior to assay are required by the instant method as well as the prior art methods.

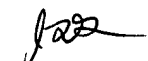
No claim is allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Grun, Ph.D., whose telephone number is (703) 308-3980. The examiner can normally be reached on weekdays from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, SPE, can be contacted at (703) 305-3399.

The phone numbers for official facsimile transmitted communications to TC 1600, Group 1640, are (703) 872-9306, or (703) 305-3014, or (703) 308-4242. Official After Final communications, only, can be facsimile transmitted to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. The above inquiries, or requests to supply missing elements from Office communications, can also be directed to the TC 1600 Customer Service Office at phone numbers (703) 308-0197 or (703) 308-0198.


James L. Grun, Ph.D.
April 15, 2003


CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP ~~1800~~ 1641
4/16/03